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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

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Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte THOMAS D. PETITE

MAILED

MAR 21 2002

Appeal No. 2000-0831  
Application 08/825,576<sup>1</sup>

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PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

ON BRIEF

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Before BARRETT, FLEMING, and LEVY, Administrative Patent Judges.  
BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 21-25. Claims 1-20 have been canceled.

We affirm.

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<sup>1</sup> Application for patent filed March 31, 1997, entitled "Transmitter for Accessing Automated Financial Transaction Machines," which claims the benefit of Provisional Application 60/040,316, filed February 14, 1997.

BACKGROUND

The disclosed invention, shown in figures 1 and 2, relates to a remote access device 20 for accessing an automated financial transaction machine (AFTM) 10 and a system for providing cardless access to an AFTM. The remote access device has a single button 22 which, when depressed, causes a controller 46 to retrieve user identification data from a memory 42 and transmit it from a low-power transmitter 48. The transmitter also transmits synchronization bits 92 and a function code 96 that specifies a function to be performed (figure 4). The invention may provide multiple functionality through the use of multiple transmit buttons, e.g., one button for initiating AFTM access, another button for activating an automobile lock/alarm system (e.g., 24 in figure 1), and still another button for providing a distress call (specification, p. 17, lines 4-11).

Claim 21 is reproduced below.

21. A remote access device for accessing a financial transaction machine comprising:

a single user-depressable button;

a memory configured to store user identification data, including track 1 and track 2 data;

a low-power transmitter; and

a controller configured to control the transmitter to transmit the track one and track two data in direct response to a manual depression of the user-depressable button, without any verification of user identification data, the controller being configured to control the transmitter to transmit a plurality of synchronization bits, track one and

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track two data, and a function code that identifies a transmitted function.

The Examiner relies on the following references:

Waraksa et al. (Waraksa) 5,319,364 June 7, 1994  
Tait et al. (Tait) 5,550,358 August 27, 1996

Skip Wollenberg, Device could speed-up visits to gas stations, The Augusta Chronicle Online business@augusta, February 19, 1997.

Claim 23 stands rejected under 35 U.S.C. § 112, first paragraph, based on a lack of written description in the specification as originally filed.

Claims 21-23 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tait and Waraksa.

Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Tait and Waraksa, as applied in the rejection of claim 21, further in view of Wollenberg.

We refer to the final rejection (Paper No. 9) (pages referred to as "FR\_\_") and the examiner's answer (Paper No. 20) for a statement of the Examiner's rejection, and to the substitute appeal brief (Paper No. 19) (pages referred to as "Br\_\_") and reply brief (Paper No. 21) (pages referred to as "RBr\_\_") for a statement of Appellant's arguments thereagainst.

OPINION

Contents of Tait and Waraksa

Tait discloses a remote access device (the hand-held transmitter 10 in figure 1 and corresponding transmitter 10B in the embodiment of figure 5), which accesses a financial transaction machine (receiver 12 and conventional swipe machine 30 in figures 1 and 3B). The device and system could be used for other than financial transactions (col. 7, lines 2-4). The embodiment of figure 5 has a single user-depressable button (switch 16B) and a memory configured to store user identification data (PROM 20B). Track one and track two data are described by Appellant as follows (specification, p. 16, lines 13-15): "As is known, track one data typically includes a person's name. Track two data, however, typically includes the person's account number and the encoded pin number." The term "typically" indicates that there is no fixed information. Usually, track one data represent alphanumeric data and track two data is numeric data. The PROM in Tait stores the owner's name (i.e., track one data) and the owner's personal credit number (i.e., similar to a credit card number or bank number, etc.) (i.e., track two data) (col. 4, lines 49-55). Tait discloses non-contactless transmission of credit card information that would normally be read by a card swipe machine 30 (e.g., col. 5, lines 6-8, 21-24; col. 5, line 53 to col. 6, line 4) and, thus,

is presumed to transmit user identification data, including track one and track two data, normally found on a credit card. The embodiment of figure 5 does not use a PIN number, but claim 21 does not specifically require a PIN number. In any case, however, Tait further discloses storing credit information and a PIN and that the user's code (PIN) can be verified at a local location (col. 6, line 55 to col. 7, line 6), which suggests storing and transmitting credit information and a PIN number. Tait discloses a low-power transmitter. The circuit of figure 5 is configured to transmit the identification data in direct response to a manual depression of the user depressable button (switch 16B), without any verification of user identification data (the PIN comparison step is omitted, col. 6, line 50). Tait discloses that a set of buttons may be provided, with one button corresponding to each credit card (col. 5, line 53 to col. 6, line 4). Tait discloses that the receiver is connected to a central data processing and storage unit (col. 2, lines 64-67; col. 3, lines 45-52).

Waraksa discloses a passive keyless entry system, i.e., a keyless entry system that does not require actuating a button. It is disclosed that remote access devices were known where the operator actuated a button or switch to initiate the transmission and perform a function such as unlocking the vehicle (col. 1, lines 18-29). This requires the operator to physically locate

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the transmitter and actuate a button to unlock the vehicle. Waraksa employs a transmitter or beacon, a receiver/controller, and a receiving antenna. Waraksa discloses that the beacon is small enough to be attached to a keychain (col. 2, lines 39-42). The beacon (transmitter) emits a coded signal that contains synchronization bits, a function code, an identification code, and an error correction code (col. 5, line 58-66). Waraksa discloses that the beacon may also be provided with function switches which, when depressed by the operator, change the function code, thus directing the receiver/controller to open the vehicle trunk and/or perform other functions (col. 2, line 67 to col. 3, line 3). "The 4-bit FUNCTION code, as previously noted, provides up to sixteen different FUNCTION codes to selectively control the activation of additional functions as desired, such as trunk unlock, unlock all doors, turn on interior lights, etc." (Col. 5, line 66 to col. 6, line 3.)

Claims 21 and 22

The Examiner finds that Tait, particularly the embodiment of figure 5, discloses the subject matter of claim 21 except for transmission of a plurality of synchronization bits and a function code along with the identification data (FR3-4). The Examiner finds that Waraksa discloses (under the heading "ERROR CORRECTION CODE" in columns 5-7) a remote access device in which the transmitter transmits a plurality of synchronization bits, a

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function code, and an identification code (FR4). The Examiner concludes that it would have been obvious to transmit synchronization bits and codes along with the identification code transmitted by Tait because Waraksa teaches that it was conventional to transmit synchronization bits, a function code, and an identification code in the art of remote access devices.

Appellant argues (Br10-11) that the Examiner relies on Waraksa as allegedly disclosing "a remote access device in which a transmitter transmits a plurality of synchronization bits, a function code and an identification code" (emphasis added) (FR4). It is argued that the identification code of Waraksa is simply a random binary value that is set to match a receiver in order to prevent activation of the keyless entry system by another having a similar transmitter and, thus, the identification code of Waraksa does not convey "user" information, much less any track 1 or track 2 data (Br11). Appellant states (at Br11) that the Examiner admits that "Tait et al. does not specifically disclose the transmission of a plurality of synchronization bits and a function code along with identification data (track 1 and track 2 data)" (FR3-4).

Appellant misapprehends the rejection, which is based on Tait for the user identification data, including track one and track two data. The Examiner's final rejection found that Tait discloses a "memory for storing user identification data

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(including track 1 and track 1 [sic, 2] data" (FR3). This is noted by the Examiner (EA3). The difference between Tait and the subject matter of claim 21 is that Tait does not disclose transmitting a plurality of synchronization bits and a function code along with the user identification data. Appellant has not shown error in the Examiner's finding that Tait stored user identification data, including track one and track two data. As discussed in our findings regarding the content of Tait, Tait discloses storing the owner's name (i.e., track one data) and the owner's personal credit number (i.e., track two data) (col. 4, lines 49-55). Track one data is normally just alphanumeric data and track two data is numeric data. Tait also discloses non-contactless transmission of credit card information that would normally be read by a card swipe machine 30, which suggests transmission of user identification data, including track one and track two data, normally found on a credit card.

Appellant notes that claim 21 claims that the invention includes a controller that is "configured to control the transmitter to transmit the track one and track two data in direct response to a manual depression of the user-depressable button, without any verification of user identification data" (emphasis added). It is argued that there is no comparable disclosure within Tait because the system in Tait requires the

user to key in a PIN number to verify her identity to the transmitter, as a matter of improved security (Br12).

Appellant has failed to carefully read the Examiner's rejection. The rejection states (FR3): "Applicant's attention is directed to the embodiment of the invention shown in Fig. 5 [of Tait] and the text pertaining thereto in column 6." The reliance on figure 5 is noted by the Examiner (EA4). Unlike the embodiment of figures 1, 3A, and 6, the embodiment of figure 5 of Tait does not have a keypad and does not perform verification of user identification data (i.e., it does not perform an internal PIN comparison). Claim 21 does not require PIN data, but, in any case, Tait discloses storing credit information and a PIN and that the user's code (PIN) can be verified at a local location (col. 6, line 55 to col. 7, line 6).

Appellant argues that the rejection fails to cite an appropriate suggestion, teaching, or motivation to combine the teachings of Tait and Waraksa (Br9; Br12). It is argued that Waraksa is directed to a passive keyless entry system for an automobile while, in contrast, Tait is directed to a wireless remote financial transaction system (Br12). Appellant argues that there is no motivation to combine select features of these allegedly vastly different systems (Br12). It is argued that Tait and Waraksa are directed to non-analogous art because there is no overlap in their U.S. patent classifications (Br12-13).

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The Examiner notes that both patents are directed to wireless remote access devices (EA4). The Examiner notes that Waraksa was cited in an information disclosure statement (Paper No. 3) and Appellant stated that the documents cited therein may be considered material (EA4).

Both Tait and Waraksa are directed to wireless remote access devices and, thus, are reasonably pertinent to the inventor's problem of designing a remote access device even if they are not in the same field of remote access devices for AFTMs. One of ordinary skill in the art would have looked to the wireless remote access device art for solutions to common problems such as data transmission, miniaturization, error correction, security, etc. In particular, one of ordinary skill in the art would have been motivated to add a plurality of synchronization bits and a function code to the user information transmitted in Tait in view of the teaching of synchronization bits in Waraksa to synchronize onto the data for more reliable data transmission and the use of function codes to perform specific functions such as those related to automobiles in dependent claim 23. In fact, since dependent claim 23 relates to an automobile lock function, it can be said the Waraksa is in the same field as Appellant's invention as well as being reasonably related to Appellant's problem.

Appellant's argument that Waraksa is nonanalogous art because it's classification does not overlap with Tait's is not

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persuasive. A patent's classification is not highly probative as to analogous art "because considerations in forming a classification system differ from those relating to a person of ordinary skill seeking solution for a particular problem."

In re Mlot-Fijalkowski, 676 F.2d 666, 669 n.5, 213 USPQ 713, 715 n.5 (CCPA 1982). Here, there are good reasons why Waraksa is analogous prior art. However, Appellant's citation of Waraksa in an information disclosure statement does not constitute an admission that it analogous prior art as found by the Examiner.

We conclude that the Examiner has established a prima facie case of obviousness which has not been shown to be in error by Appellant. The rejection of claim 21 and claim 22 (which is grouped to stand or fall together with claim 21) is sustained.

#### Claim 23

##### 35 U.S.C. § 112, first paragraph, written description

The Examiner states that the application, as originally filed, does not disclose a remote access device for accessing a financial transaction machine comprising a single user-depressable button and a function code selected from the group consisting of automatic financial machine access, a test code, an automobile lock, and a distress call (FR2). The Examiner refers to page 17 of the specification (FR2).

Appellant argues (Br14) that almost verbatim support for the group of function codes is found in the specification at page 16,

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lines 15-19. It is argued that the Examiner fails to recognize the embodiment on page 17 where multiple functionality is provided by multiple transmit buttons (Br15).

The Examiner elaborates on the rejection by stating that the single button is disclosed as only transmitting a function code that defines automatic financial transaction access and to transmit a function code that defines a test code, automobile lock, or distress call function requires more than a single button as evidenced by page 17 of the specification (EA5).

The problem with claim 23 is best seen by inspecting claim 21. Claim 21 recites a "device for accessing a financial transaction machine" (preamble) and a single user-depressable button for causing the transmitter to transmit a plurality of synchronization bits, user identification data, including track one and track two data, and a function code. Thus, claim 21 appears to be directed to a device for performing automated financial transaction machine (AFTM) access, although it does not recite that the function is AFTM access. Claim 23 recites functions other than AFTM access, but does not recite that other buttons are provided--it uses the same button as claim 21. No device is disclosed that could satisfy the limitations of claim 21 and perform one of the non-AFTM access functions of claim 23 with the single button of claim 21. Although Appellant mentions the multiple button embodiment, it has not been

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explained whether claim 23 is supposed to have another button for the non-AFTM access functions or whether claim 21 can be interpreted in some way that is not inconsistent with claim 23. We sustain the written description rejection of claim 23.

The rejection might have fit better under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which Appellant regards as his invention. For example, does claim 23 require a second button to perform non-AFTM access? Or, would a device which transmits an automobile lock function need to transmit user identification data, including track one and track two data? There is also a question under 35 U.S.C. § 112, fourth paragraph, whether claim 23 further limits claim 21 from which it depends because the non-AFTM access functions appear to change, rather than further limit, the implied AFTM access function of claim 21.

35 U.S.C. § 103(a)

Claim 23 defines the function code as a function selected from the group consisting of: automatic financial transaction machine access, a test code, an automobile lock, and a distress call. Appellant argues that these features are not disclosed within the prior art of record (Br13). Appellant reasserts that the Examiner failed to cite a legally sufficient teaching, suggestion, or motivation to combine Tait and Waraksa (Br14).

We do not find where the Examiner addresses the obviousness of the limitations of claim 23 in the final rejection or the examiner's answer. We do not know whether the Examiner is relying on the § 112, first paragraph, rejection of this claim as a reason not to apply prior art to the claim or is relying a teaching clearly evident in one of the references. Tait does not expressly disclose transmission of a function code along with the user identification data, presumably because the function (identification for AFTM access) is implied when there is only one function. Nevertheless, Waraksa discloses that it was well known to send an automobile lock coded function (col. 1, lines 14-29). Waraksa discloses transmission of a function code to lock and unlock an automobile, open the vehicle trunk and/or perform other functions either passively (without pressing a key) or by pressing a key (col. 2, line 59 to col. 3, line 3; col. 5, line 66 to col. 6, line 3). Tait teaches the use of plural selectable buttons (col. 5, line 53 to col. 6, line 4). It would have been obvious to add an automobile lock function to Tait or to dedicate one of the selectable buttons in Tait to another function in view of Waraksa's teaching of multiple buttons for multiple functions. The rejection of claim 23 is sustained.

Furthermore, if claim 21 does not require transmitting financial transaction data, then claims 21 and 23 would have been obvious over Waraksa alone aside from the user identification

data, including track one and track two data, which seem to serve no function in an automobile lock function.

Claim 24

Appellant argues that the Examiner's act of citing Wollenberg implicitly admits that it was necessary to point to a reference for the teaching of configuring the device in Tait for attachment to a key ring (Br18). It is argued that the portion of Tait, beginning at column 6, line 65, which states that "the size and shape of the transmitter may be varied and, in fact, depending on manufacturing technology, the transmitter may be credit card shaped to fit in a wallet or the like," only mentions a credit card structure, not the key ring structure recited in claim 24 (Br18). Thus, it is argued, the prior art of record fails to disclose the "key ring" limitation of claim 24.

We note that Waraksa discloses that the beacon (transmitter) is small enough to be attached to a keychain (col. 2, lines 39-40). It would have been obvious to make the transmitter in Tait in a size and shape to be attached to a key ring in view of the teaching in Waraksa that remote access devices can be shaped to fit on a keychain. Moreover, such modification would have been even more obvious when the function is related to an automobile, such as the automobile lock function in claim 23, which uses keys. Thus, it is not necessary to rely on Wollenberg. The rejection of claim 24 is sustained over Tait and

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Waraksa alone. Nevertheless, we will also sustain the rejection based on the Speedpass described in Wollenberg.

Appellant argues that Wollenberg does not constitute prior art because it has a publication date of February 19, 1997, whereas the application claims the benefit of Provisional Application 60/040,316, filed February 14, 1997. It is argued that any statements in the article amount to hearsay and cannot be used as proof that such a system was in public use as of that date (Br17). It is argued that competitors could otherwise defeat a patent by falsifying statements after the filing date of about prior possession of the invention (Br17).

It is true that Wollenberg itself is not prior art. It is the Mobil Speedpass that is the prior art. It is possible to use subsequently published documents as evidence of "in public use or on sale" prior art and level of skill in the art before Appellant's filing date. See In re Epstein, 32 F.3d 1559, 1563-67, 31 USPQ2d 1817, 1819-23 (Fed. Cir. 1994) (prior art software products described in writings dated after applicant's filing date). The rules of evidence and, in particular, the rules against hearsay evidence do not apply during ex parte examination. Id. at 1565-66, 31 USPQ2d at 1821. The test is whether the statement offered is free enough from the risk of inaccuracy and untrustworthiness. Id. at 1566, 31 USPQ2d at 1821-22. Here, we have no reason to believe that the description

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that the Mobil "Speedpass is a cylinder about an inch long and a quarter inch in diameter that can be attached to a ring with the car keys" and the statement that "Mobil has been testing the passes since August [1996] in St. Louis with 11,000 customers and 55 stations," are inaccurate or that the author of the story is untrustworthy. Appellant has given us no reason to doubt the veracity of the descriptions.

Appellant argues that Wollenberg states that the device will not be introduced until May and, thus, by admission the devices were not yet publicly available. As to the description that Mobile has been testing the devices since August 1996, there is no indication as to any confidentiality associated with the test group and the act of testing may not be prior art (Br18).

We find that a test "with 11,000 customers and 55 stations," as stated in Wollenberg, presents a prima facie case of public use. It seems highly unlikely that such a large scale test could be kept confidential. The fact that the Speedpass was tested in a limited market of one city before being put into nationwide use does not make the use any less of a public use.

Accordingly, we hold that the Speedpass described in Wollenberg is prior art as a public use. It would have been obvious to make the transmitter in Tait in a size and shape to be attached to a key ring in view of the Speedpass. The rejection

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of claim 24 is sustained as obvious over Tait and Waraksa and over Tait, Waraksa, and the Speedpass described in Wollenberg.

Claim 25

Most of Appellant's arguments with regard to claim 25 have been discussed in the analysis of claim 21 and we refer back to that discussion for our reasoning.

Appellant also argues that "claim 25 defines a remote access device having both a magnetic card reader and a receiving means for receiving data from the remote access device" (Br21) and that this additional limitation further distinguish claim 25 over the prior art of record (Br21).

The Examiner correctly points out (EA6) that Tait discloses both a magnetic card reader 30 and a receiver 12 for receiving data from the remote access device 10. See Figures 1 and 3A, 3B. Thus, Appellant's argument is not persuasive.

Appellant further argues that "[c]laim 25 also defines a network for communicating user identification data to a remote location" (Br21) and that this additional limitation further distinguish claim 25 over the prior art of record (Br21).

The Examiner correctly points out (EA6) that Tait discloses (col. 3, lines 45-52; also col. 2, lines 64-67) the receiver is connected to a central data processing and storage unit. Thus, Appellant's argument is not persuasive.

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We conclude that the Examiner has established a prima facie case of obviousness which has not been shown to be in error by Appellant. The rejection of claim 25 is sustained.

## CONCLUSION

The rejections of claims 21-25 are sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

*Lee E. Barrett*  
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 )  
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